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Paper No. 6

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AUG 26 2002

OFFICE OF PETITIONS

In re Application of :
Mark Colaio : DECISION REFUSING STATUS
Application No. 10/015,739 : UNDER 37 CFR 1.47(b)
Filed: 12 December, 2001 :
Atty Dckt No. CF-36 :
:

This is in response to the petition under 37 CFR 1.47(b) filed on 24 June, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified reissue application was filed on 12 December, 2001, without an executed oath or declaration.

Accordingly, on 23 January, 2002, a "Notice To File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on 24 June, 2002, the present petition was filed, along with a three (3) month extension of time, authorization to charge the petition fee and surcharge to counsel's deposit account were filed, accompanied by, *inter alia*: a declaration naming Mark Colaio as the sole inventor and signed by Howard

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Petitioner asserts that the inventor was present in the World Trade Center, Tower 1, on 11 September, 2001, and is missing and presumed dead. Petitioner asseverates that a copy of the application was sent to the legal representative of the deceased sole inventor, June Colaio. Petitioner further asserts that the legal representative has failed to sign and return the declaration. In support, petitioner has submitted a copy of a letter sent to the legal representative of the deceased inventor transmitting the declaration to her.

A grantable petition under 37 CFR 1.47(b) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a statement of the last known address of the non-signing inventor;
- (5) proof of proprietary interest, and
- (6) proof of irreparable damage.

The petition lacks items (1), (2), (5), and (6).

In regards to item (1), before a refusal to sign can be alleged, a copy of the application (specification, including claims, drawings, if any, and the declaration), must be sent or given to the legal representative of the deceased inventor. The letter dated 16 January, 2002, does not state that a copy of the application was forwarded to the inventor's legal representative. Petitioners may provide proof by supplying a copy of the cover letter transmitting the application papers to the non-signing inventor's legal representative or provide details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

If the legal representative refuses in writing to sign the declaration, petitioners should provide a copy of that written refusal with any renewed petition. If the refusal is made orally, then a person with first hand knowledge of the details of the refusal must provide details of the refusal in an affidavit or declaration of facts.

In regards to item (2), the oath or declaration must identify the name, residence, mailing address, and citizenship of the legal representative of the deceased inventor, and state that the legal representative is signing on behalf of the deceased joint inventor. The name, residence, mailing address, and citizenship of the deceased inventor must also be provided. Additionally, the declaration must be signed by an officer of the corporation (president, vice president, secretary, or treasurer) on behalf of and as agent for the legal representative of the deceased inventor. The officer must identify his/her title in the declaration. Additionally, the residence, mailing address, and citizenship of the officer signing the declaration must be provided. If the declaration is not signed by an officer of the corporation, then proof of authority of the person signing on behalf of the corporation must be submitted.¹ Attention is directed to 37 CFR 1.63(a)(3); MPEP §§ 605.02, 605.03. An oath or declaration in compliance with 37 CFR 1.63 and 1.64, properly identifying the application by application number and filing date, is required.²

In regards to item (5), petitioners have not shown sufficient proprietary interest in the subject matter to justify filing of the application under 37 CFR 1.47(b).³³ Petitioners may provide proof by showing a copy of the employment agreement between the non-signing inventor and the Rule 1.47(b) applicant (company); a copy of an assignment agreement showing that the invention disclosed in the application is assigned to the Rule 1.47(b) applicant, or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to the Rule 1.47(b) applicant.

In regards to item (6), petitioners must provide proof of irreparable damages as specified in MPEP 409.03(g). A statement by applicant that the filing is necessary to prevent irreparable damage or to preserve the rights of the parties is sufficient.

¹See MPEP 409.03(b).

²See MPEP 409.03(b).

³MPEP 409.03(f).

The petition fee of \$130.00 has been charged to counsel's deposit account, No. 06-1075, as authorized in the "Response to Notice to File Missing Parts of Nonprovisional Application" filed with the present petition on 24 June, 2002.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at (703) 308-6918.



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